

JUN. 22. 2004 3:06PM

ROCHE PATENT LAW

NO. 0950 P. 1

Fax Cover Sheet



Pharmaceuticals

To: Binta Robinson USPTO
Fax: 571-273-0692

From: Dennis P. Tramaloni Hoffmann La Roche
Patent Law Department
Tel. 973-235-4475
Fax 973-235-2363

Date: 22 June 2004
Re: US Application No. 10/670,182 filed September 24, 2003
4-PYRIDINYL-N-ACYL-L-PHENYLALANINES
Docket No. 20515 US4

No. of pages: 9 (incl. cover sheet)

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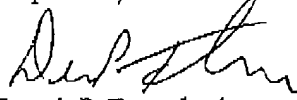
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Dear Examiner Robinson:

Further to our telephone discussions of June 21 and 22, 2004, telefaxed herewith please find a Terminal Disclaimer disclaiming the terminal part of U.S.S.N. 10/670,182, filed September 24, 2003 over the term of grandparent application and now issued U.S. Patent No. 6,388,084. Also enclosed, as discussed, is a Supplemental Information Disclosure Statement citing 3 additional patents.

We thank you for the courtesies extended in agreeing to telefax delivery of the above documents in order to facilitate allowance of the claims over the '084 patent and consideration of the supplemental references.

Respectfully submitted,


Dennis P. Tramaloni
(Reg. No. 28,542)

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PTO/SB/21 (02-04)

Approved for use through 07/31/2006. OMB 0651-0031

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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	10/670,182
	Filing Date	September 24, 2003
	First Named Inventor	Kaplan
	Art Unit	1625
	Examiner Name	Binta Robinson
Total Number of Pages in This Submission	Attorney Docket Number	20515 US4

ENCLOSURES (Check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input checked="" type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input checked="" type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):
Remarks <p style="text-align: center;">Form 1449</p>		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm or Individual name	Dennis P. Tramaloni
Signature	<i>Dennis P. Tramaloni</i>
Date	June 22, 2004

CERTIFICATE OF TRANSMISSION/MAILING	
I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.	
Typed or printed name	Dennis P. Tramaloni
Signature	<i>Dennis P. Tramaloni</i>
Date	June 22, 2004

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application
G.L. Kaplan et al.

Group: 1625

Serial No. 10/670,182 filed September 24, 2003
Docket No. 20515 US4

Examiner: Binta Robinson

For: 4-PYRIDINYL-N-ACYL-L-PHENYLALANINES

TERMINAL DISCLAIMER

Nutley, New Jersey 07110
June 22, 2004

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Hoffmann-La Roche Inc., a corporation of the state of New Jersey, having an office at 340 Kingsland Street, Nutley, New Jersey 07110, is the assignee of the entire right, title and interest in and to the invention described and claimed in the captioned application for Letters Patent of the United States, and in and to said application and in and to any and all Letters Patent of the United States which may issue from said application, by virtue of an Assignment by Gerald Lewis Kaplan, Achyutharao Siddurt and Jefferson Wright Tilley to Hoffmann-La Roche Inc., recorded in the United States Patent and Trademark Office on June 4, 2001 at reel 011856, frame 3761.

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Serial No. 10/670,182

Hoffmann-La Roche Inc. hereby certifies that the evidentiary documents have been reviewed, and, to the best of Hoffmann-La Roche Inc.'s knowledge and belief, title to the captioned application is in Hoffmann-La Roche Inc.

Hoffmann-La Roche Inc. hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the captioned application which would extend beyond the expiration date, including any extension obtained under 35 USC 156, of U.S. Patent No. 6,388,084 issued May 14, 2002.

Hoffmann-La Roche Inc. further agrees that any patent so granted on the captioned application, together with any right to recover for its violation, shall be enforceable only for and during such period that the legal title to any patent granted on the captioned application shall be the same as the legal title to U.S. Patent No. 6,388,084 issued May 14, 2002. This agreement to run with any patent granted on the captioned application and to be binding upon the grantee, its successors or assigns.

Hoffmann-La Roche Inc. does not disclaim the terminal part of the term of any patent granted on the captioned application prior to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of U.S. Patent No. 6,388,084 issued May 14, 2002, as presently shortened by any terminal disclaimer, in the event that said patent: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent

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jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. 1.321, has all claims cancelled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

Hoffmann-La Roche Inc. makes the above disclaimer without prejudice to its rights to extend, under 35 U.S.C. 154-156, the term of any U.S. patent granted on the captioned application beyond the term provided by this Terminal Disclaimer.

The undersigned has authority to sign on behalf of Hoffmann-La Roche Inc. as an attorney of record in the above captioned application.

The statutory fee of one hundred ten dollars (\$110.00) is being charged to Deposit Account No. 08-2525 as per the document submitted herewith in triplicate. The Commissioner is hereby authorized to charge any fees which may be required, or credit any over payment to Account No. 08-2525.

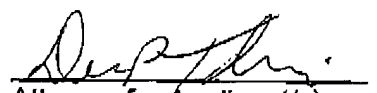
I declare further that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States

Serial No. 10/670,182

Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Signed at Nutley, State of New Jersey, this 22 day of June, 2004.

Respectfully submitted,


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